

REMARKS/ARGUMENTS

This response is submitted within three months after the shortened statutory period of three months to respond to the office action dated March 29, 2004. Therefore, a petition and fee for extension of time is filed with this response.

I. Claims

This response amends currently pending Claims 1, 2, 4, 6, 14, 15, and 20. No Claims are canceled and no new Claims are added. After amendment this application will have one independent Claim (currently amended Claim 1) and a total of 20 Claims (currently amended Claims 1, 2, 4, 6, 14, 15, and 20 and currently pending Claims 3, 5, 7-13, and 16-19. Applicant respectfully maintains that the present amendments add no new matter and are fully supported by the specification as originally filed. Applicants previously paid for up to 20 total Claims and 3 independent Claims. No fee for excess Claims is due with this response.

II. Oath/Declaration

The Examiner objects to the oath or declaration under 37 CFR 1.67(a) as being allegedly defective. The Examiner asserts that the declaration must have both the residence and the mailing address of the inventor. Applicants respectfully traverse the Examiner's objection. The declaration lists one Inventor Hoon Bum Lee. The declaration further lists the residence of Mr. Lee. The last line for the Post Office Address reads "same as residence". Therefore, the residence and the mailing address are the same and both listed in the declaration. The Examiner is respectfully asked to withdraw the objection to the oath or declaration under 37 CFR 1.67(a).

III. Objection to Claim 14 under 35 U.S.C. § 132

The Examiner objects to Claim 14 under 35 U.S.C. § 132 because it allegedly introduces new matter into the disclosure, since Claim 14 was introduced with the previous response reciting the element "magnetically operated plunger type". The Applicant respectfully traverses the Examiner's objection. The Applicant points out that the disclosure contains the element "electric motor". It is believed that the interpretation of electric motor comprises electro-mechanical and electro-dynamic devices. It is further believed that a "magnetically operated plunger type" belongs to this group of electro-mechanical and electro-dynamic devices as long as the magnetic field is generated by electrical means. The Examiner is therefore respectfully asked to withdraw the objection to Claim 14 under 35 U.S.C. § 132.

IV. Claim Objections and Claim Rejections under 35 U.S.C. § 112, second paragraph.

The Examiner objects to and rejects currently pending Claims 1-6, 10-15, and 18-20 in items 5-9 of the Office action. Claims 1, 2, 4, 6 and 14 were amended to overcome the claim objections and rejections under 35 U.S.C. § 112, second paragraph. Applicant therefore respectfully requests that the Examiner withdraw the objections and rejections under 35 U.S.C. § 112, second paragraph.

V. Claim Rejections under 35 U.S.C. § 103

The Examiner rejects currently pending Claims 1-5, 10-13, 15, 18 and 19 under 35 U.S.C. § 103 (a) over U.S. Patent No. 5,251,641 (hereinafter called "Xavier") in view of U.S. Patent No. 5,961,534 (hereinafter called "Banik").

1. *Independent Claim 1*

The independent Claim 1 has the following claim limitations:

"A device for executing a hair-transplanting procedure of harvesting a hair graft from hairy area on a scalp and then implanting the hair graft into a bald area, in series, comprising:
first cutting member affixed to a front part of the device and having an elongate and hollow shape, wherein the first cutting member has a blade at the front end of which a surface ("imaginary surface") which forms the entrance of the first cutting member inclines toward a side of the first cutting member, wherein a hair graft is cut by the blade and then is introduced into the device as the front end of the device is pushed into the scalp during a hair graft harvesting operation;
second cutting member having an elongate and hollow shape, and disposed to move forward as well as backward, or revolve, with respect to the first cutting member, wherein the second cutting member has a blade at its front end of which the surface ("imaginary surface") cuts a bottom portion of the hair graft having been introduced into the device and then meets the blade surface of the first cutting member as the second cutting member moves forward fully during a hair graft harvesting operation, whereupon the blade faces of the first and second cutting members face each other;
extrusion member disposed to move forward as well as backward in the innermost elongated and hollow space inside of the first and the second cutting member and having an elongate shape, wherein the extrusion member pushes out the hair graft loaded in the device during a hair graft harvesting operation and pushes the hair graft into a cavity made by the front end of the device on a scalp as the extrusion member moves forward during a hair graft implanting operation;
and
housing forming an outward shape and providing an induction road for movements of the second cutting member and the extrusion member."

2. *Xavier and Banik*

Xavier discloses a biopsy needle. Banik discloses a multi-motion side cutting biopsy sampling device.

The Applicant reminds the Examiner respectfully that a biopsy is the removal of a sample of tissue from the body for examination. The tissue will be examined under a microscope to assist in diagnosis. Therefore, only very small samples are needed. See for example:

http://www.netdoctor.co.uk/health_advice/examinations/biopsy.htm.

In a liver biopsy (BYE-op-see), for example, the physician examines a small piece of tissue from the liver for signs of damage or disease. A special needle is used to remove the tissue from the liver. The physician decides to do a

liver biopsy after tests suggest that the liver does not work properly. Looking at liver tissue itself is the best way to determine whether the liver is healthy or what is causing it to be damaged. See for example:

<http://digestive.niddk.nih.gov/ddiseases/pubs/liverbiopsy/>.

3. *Invention as claimed in Claim 1*

However, the invention as claimed in Claim 1 recites a device for executing a hair-transplanting procedure of harvesting a hair graft from a hairy area on a scalp and then implanting the hair graft into a bald area, in series.

Even the Examiner admits that Xavier's device is not meant to perform a hair-transplanting procedure. The Examiner admits further that Xavier's device does not include an extrusion member to push a hair graft out.

However, the Examiner tries to combine the teaching of a biopsy needle of Xavier with the teaching of biopsy device of Banik and asserts that it would have been obvious for the person skilled in the art to include an extrusion member with the device of Xavier in order to push the collected biopsy sample out of the holding chamber for inspection by the medical personnel as taught by Banik.

The Applicant submits that the biopsy needles as taught by Xavier and Banik have nothing to do with a device for executing a hair-transplant. The Applicant further submits that Banik does not disclose an extrusion member disposed to move forward as well as backward in the innermost elongated and hollow space inside of the first and the second cutting member and having an elongate shape, wherein the extrusion member pushes out the hair graft loaded in the device during a hair graft harvesting operation and pushes the hair graft into a cavity made by the front end of the device on a scalp as the extrusion member moves forward during a hair graft implanting operation, as recited in Claim 1.

Banik discloses a rod 25, which can be moved axially distally to remove samples from the device. Banik does not suggest using the rod 25 as an extrusion

member according to Claim 1. Neither Xavier nor Banik suggest using the biopsy needle for hair transplanting.

4. *Prima Facie* Case of Obviousness

The Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness by combining the teaching of Xavier with the teaching of Banik for the following reasons.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP 2142.

The combined teaching of Xavier and Banik does not teach or suggest all the claim limitations. The combined teaching does not teach or suggest a device for executing a hair-transplant. The combined teaching does not teach or suggest an extrusion member.

There is no suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings and to make the invention of Claim 1. The two references which deal with biopsy devices without even mentioning hair-transplantation do not suggest or motivate the person skilled in the art to modify the teaching of Xavier or to combine the teaching of Xavier with the teaching of Banik and to make the invention as claimed in Claim 1.

Finally, there would be no expectation of success to combine the teaching of Xavier and Banik. If the person skilled in the art would combine the teaching

of Xavier and Banik he or she would only obtain a biopsy needle according to Xavier improved by a rod to plunge out a biopsy sample according to Banik.

The Applicant submits that any motivation to combine Xavier with Banik is provided by the Applicant's disclosure, and not by the prior art.

Hence, the Applicant submits that the rejection of currently amended Claim 1 under 35 U.S.C. 103(a) as being unpatentable over Xavier and further in view of Banik is improper. The Applicant respectfully requests that the rejection of Claim 1 on these grounds be withdrawn.

The Examiner did not produce a *prima facie* case of obviousness. Applicant asserts that since independent amended Claim 1 should be allowable, the dependent Claims 2-20 should be allowable as well.

Accordingly, reconsideration and examination of the present application is respectfully requested.

The application is now in condition for allowance. Allowance of the application at an early date is respectfully requested.

The Applicants reserve the right to seek protection for any unclaimed subject matter either subsequently in the prosecution of the present case or in a divisional or continuation application.

This response amends Claims 1, 2, 4, 6, 14, 15, and 20. The amendments that are described in the preceding sentence were done to more fully claim the invention and/or to improve the wording of the Claims and were not done to overcome rejections under 35 U.S.C. §112, to overcome the prior art or to overcome any other rejections or objections.

The Commissioner is authorized to charge any additional fees, which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on

Respectfully submitted,

September 28, 2004

(Date of Deposit)

Corinda Humphrey


(Name of Person Signing)



(Signature)

September 28, 2004

(Date)



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Enclosures

Petition for Extension of Time

Check No. 19557